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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,933	08/07/2001	Joseph D. Macchia	045297.0001	3928

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EXAMINER

RINES, ROBERT D

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/923,933

Applicant(s)

MACCHIA, JOSEPH D.

Examiner

Robert D. Rines

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice to Applicant***

[1] This communication is in response to the patent application filed 7 August 2001. Claims 1-20 are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

[2] Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the applicant recites the phrase "wherein the seller of provider" in line 1 of claim 3. It is unclear as to the involved party the applicant wishes to designate with this phrase. Appropriate correction is required. The examiner assumes a typographical error and further, the examiner is assuming that the applicant intended to recite the phrase "insurance provider" in place of "seller or provider". For the purposes of applying art, the examiner will treat claim 3 accordingly below.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[3] Claims 11-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Jinks, United States Patent Application Publication #2002/0055862.

[A] As per claim 11, Jinks teaches a method of selling insurance, comprising the steps of assigning an underwriter employed by an insurance company to an office of an insurance provider (Jinks; Abstract and paragraphs [0006] [0040]); providing underwriting service from the underwriter to the insurance provider to determine a rate for a potential customer of the insurance provider (Jinks; paragraphs [0006] [0040]); and selling an insurance policy written by the insurance company to the potential customer based upon the rate (Jinks; paragraphs [0006] [0015]).

[B] As per claim 12, Jinks teaches the insurance provider is a general agent (Jinks; paragraph [0039]).

[C] As per claim 13, Jinks teaches the insurance provider is an insurance broker or a general agent (Jinks; paragraph [0039]).

[D] As per claim 14, Jinks teaches further comprising the step of providing underwriter with a computing device loaded with data related to an insurance rating system employed by the insurance company (Jinks; paragraph [0019] and Fig. 1).

[E] As per claim 15, Jinks teaches further comprising the step of periodically updating the data (Jinks; paragraphs [0019] [0021])

[F] As per claim 16, Jinks teaches that the data are updated through a communication link between the computing device and the insurance company (Jinks; paragraphs [0019] [0021]).

[G] As per claim 17, Jinks teaches a method of distributed insurance underwriting, comprising the steps of: locating a plurality of insurance underwriters at a plurality of locations (Jinks; paragraphs [0019] [0039] [0040]), each location of the plurality of locations corresponding to a particular insurance provider of a plurality of insurance providers (Jinks; paragraphs [0023] [0040]); providing underwriting services to each the plurality of insurance providers from the corresponding insurance underwriters; (Jinks; paragraph [0040]) selling insurance through each insurance provider based upon the underwriting services of the corresponding insurance underwriter (Jinks; paragraphs [0015] [0040]).

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[H] As per claim 18, Jinks teaches that the insurance provider is a general agent (Jinks; paragraph [0039]).

[I] As per claim 19, Jinks teaches that the insurance provider is an insurance broker or a general agent (Jinks; paragraph [0039]).

[J] As per claim 20, Jinks teaches further comprising the step of providing each underwriter with a computing device of a plurality of computing devices (Jinks; paragraph [0019]), each computing device loaded with data related to an insurance rating system employed by the insurance company (Jinks; paragraphs [0019] [0021]).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

[4] Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman et al., (United States Patent Application Publication #2002/0002475) in view of Jinks.

[A] As per claim 1, Freedman et al., teaches identifying an insurance provider who is potentially suitable for a dedicated underwriter program sponsored by an insurance company (Freedman et al.; paragraphs [0080] [0097] [0103] [0110]); evaluating the insurance provider based upon the potential business that the dedicated underwriter program can generate (Freedman et al.; paragraphs [0074] [0096]); provide an insurance underwriter (Freedman et al.; paragraphs [0110] [0111]), for the exclusive use of the insurance provider (Freedman et al.; paragraphs [0110] [0111]), for generating one or more insurance quotes for the potential business (Freedman et al.; paragraphs [0110] [0111]); and providing the one or more quotes to the insurance provider (Freedman et al.; paragraphs [0150]).

[i] Although Freedman et al., teaches that one embodiment of his invention would include a "Company establishing strategic marketing alliances with various companies, including

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Agents/Brokers, that have a strong influence in the Company's target markets" (Freedman et al.; paragraphs [0074] [0079]), Freedman et al., does not specifically state that a "threshold" of potential increased business or market share is used in identifying agents that have a "strong influence in the Company's target markets". However, the examiner is interpreting Freedman's teaching of assessing the relative value of a strategic partner based on a "strong" versus a weak influence in target markets to be inclusive of determining if the gain in added business through alliance with the identified agent or agency is sufficient to justify the partnership, i.e., based on a threshold of potential gained business or number of policies written.

[ii] Although Freedman et al., indicates that among the advantages of his system is the opportunity for the "Company's management to exercise full underwriting control", Freedman et al., does not specifically teach that the underwriter is employed by the insurance company or carrier.

[iii] However, Jinks does teach providing underwriting services by an underwriter employed by the insurance company (Jinks; paragraph [0040]).

[iv] It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Freeman et al., with those of Jinks. Such combination would have resulted in an insurance system and method with which the insurance company could assess the marketing/strategic value of agents (Freedman et al.; paragraphs [0074] [0079]), establish a network a agents determined to have a strong market influence with



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the company's target consumers/markets (Freedman et al.; paragraph [0074]), and deploy the company's underwriters and underwriting services to assist the agents in the network in generating new business (Jinks et al.; paragraph [0040]). The motivation to combine would have been to enable strategic partners/agents to immediately identify risks that cannot be automatically assessed and provide a means for the routing of those risks, together with all of the information concerning the risk, directly to an underwriter who may utilize other system tools to evaluate the risk (Jinks; paragraphs [0015] [0040]).

[B] As per claim 2, Freedman et al., teaches wherein the insurance provider is a general agent (Freedman et al.; paragraph [0096]).

[C] As per claim 3, Freedman et al., teaches, wherein the seller of provider (insurance?) is an insurance broker or a general agent (Freedman et al.; paragraph [0039]).

[D] As per claim 4, although Jinks does not specifically require that the insurance underwriter is located at an office of an insurance provider, an insurance agent acting within the system taught by Jinks is able to issue a quote, automatically create a binder for the policy or actually issue the policy in accordance predefined underwriting rules, defined by the Company for the use of the agent and accessed by the agent via a networked environment (Jinks; paragraph [0015]). By virtue of the agent's inclusion within the networked system of Jinks, a managing insurance carrier implementing the invention of Jinks has endowed an authorized agent with the ability to perform at least some underwriting functions from the office of the agent and has thereby located an underwriter at the office of the insurance provider.

[E] As per claim 5, Jinks teaches further comprising the step of providing the insurance underwriter with a computing device loaded with data related to an insurance rating system employed by the insurance company (Jinks; paragraph [0019] and Fig. 1).

[F] As per claim 6, Jinks teaches further comprising the step of periodically updating the data (Jinks; paragraphs [0019] [0021]).

[G] As per claim 7, Jinks teaches wherein the data are updated through a communication link between the computing device and the insurance company (Jinks; paragraphs [0019] [0021]).

[H] As per claim 8, Although Jinks teaches the agent interfaces include a memory device such as a hard disk or other storage device (Jinks; paragraph [0019]), Jinks does not specifically teach a compact disc. The examiner is interpreting Jinks' "other storage device" to be inclusive of the applicant's compact disc wherein the data are updated by a compact disc loaded on the computing device.

[I] As per claim 9, Freedman et al., teaches wherein the threshold of potential business is thirty insurance policies per day (Freedman et al.; paragraph [0074] see claim 1 above).

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[J] As per claim 10, Freedman et al., teaches wherein the threshold of potential business is based upon a combination of a number of insurance policies written and a hit ratio (Freedman et al.; paragraph [0074] see claim 1 above).

[i] Regarding claims 2-10, the obviousness and motivation to combine as discussed with regard to claim 1 above are applicable to claims 2-10 and are herein incorporated by reference.

### *Conclusion*

[5] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Luchs et al., COMPUTERIZED INSURANCE PREMIUM QUOTE REQUEST AND POLICY ISSUANCE SYSTEM, United States Patent #4,831,526.

Huff, AUTOMATIC INSURANCE DATA EXTRACTION AND QUOTE GENERATING SYSTEM AND METHODS THEREFOR, United States Patent Application Publication #2002/0194033.

Peach, ELECTRONICALLY ACQUIRING AND DISTRIBUTING INSURANCE POLICY DATA TO AGENT OFFICES, United States Patent Application Publication #2001/0049611.

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Labelle et al., SYSTEM AND METHOD OF DISPENSING INSURANCE THROUGH A  
COMPUTER NETWORK, United States Patent Application Publication #2002/0120476.

Almeida et al., METHOD AND SYSTEM FOR DELIVERING CUSTOMER SERVICES TO  
INDEPENDENT INSURANCE AGENTS, United States Patent Application Publication  
#2004/0083125.

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Robert D. Rines whose telephone number is 571-272-5585. The  
examiner can normally be reached on 8:30am - 5:00pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the  
organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent  
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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RDR

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10/28/05

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